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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,569	05/31/2001	Robert J. Feilbogen	10251-027	3485

7590
Proskauer Rose LLP
Patent Department
1585 Broadway
New York, NY 10036

09/19/2007

EXAMINER

BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
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3693

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09/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/871,569	Applicant(s) FEILBOGEN ET AL.	
	Examiner Jason M. Borlinghaus	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/12/07 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 and 22 claim "from one of the plurality of FX rate providers or a foreign exchange liquidity provider having current market exchange rates, including....". Examiner is uncertain whether the claim limitation "having current market exchange rates, including..." pertains to both "FX rate providers" and "a foreign exchange liquidity provider", or just to "a foreign exchange liquidity provider."

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boesch (US Patent 5,897,621) in view of Poole (US Patent 6,460,020) and Mancini (US Patent 7,024,383).

Regarding Claims 1 – 12 and 15 - 18, Boesch discloses a computerized method for monitoring business transactions to provide foreign currency exchange hedging instructions and to provide foreign currency price information for goods of commerce, comprising the steps of:

- receiving by a hedging processor (server) business transaction information regarding at least one of purchases or sale of goods by a customer (customer computer or merchant computer). (see col. 3, line 50 – col. 4, line 17);

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- receiving hedging rules (instructions) from the customer and set by the customer, wherein said hedging rules (instructions) define rules to exchange a first type of currency (customer selected currency A) to a second type of currency (merchant selected currency P). (see col. 7, lines 30 – 59);
- generating by the hedging processor (server) public price information (exchange rate data) to provide foreign currency prices of said goods to the customer, based on said pricing rules (business rules) and based on public price information provided by a plurality of foreign exchange (FX) rate providers (one or more currency brokers). (see col. 8, line 49 – col. 9, line 3; col. 11, lines 6 – 43);
- generating by the hedging processor (server) hedging instruction information to provide instructions (approval/disapproval) on whether to exchange from said first type of currency to said second type of currency, based on said hedging rules (predetermined criteria). (see col. 9, lines 4 – 52);
- forwarding the hedging instruction information (data) to one of the plurality of FX rate providers (currency broker, bank or financial institution). (see col. 14, lines 2 – 14);
- receiving, by the one of the plurality of FX rate providers (currency broker, bank or financial institution), an amount of currency of the first type. (see col. 14, lines 2 – 14);
- exchanging (converting), by the one of the plurality of FX rate providers (currency broker, bank or financial institution) in response to receiving the

hedging instruction information (data), currency of the first type of currency of the second type. (see col. 14, lines 2 – 14); and

- paying an amount of currency of the second type into an account of the customer (merchant account). (see col. 10, lines 45 – 64);
- wherein said transaction information is received via at least one transaction data stream (transmission of transaction amount), wherein said public price information is generated as at least one price data stream (exchange rate data), and wherein said hedging instruction information (approval/disapproval) is generated as at least one hedging instruction data stream. (see col. 7, lines 40 – 47; col. 8, lines 49 – 58; col. 9, lines 4 – 52);
- further comprising the step of receiving market rate information (exchange rate data) from one of the plurality of FX rate providers or a foreign exchange liquidity provider providers (currency broker, bank or financial institution) having current market foreign exchange rates (updated exchange rate data), including rates for exchanging said first type of currency to said second type of currency. (see col. 8, line 49 – col. 9, line 3);
- wherein said step of generating said public price information (displayed exchange rate data displayed to customer) is further based on the received market rate information (exchange rate data received from currency broker, bank or financial instrument). (see col. 8, line 49 – col. 9, line 3; col. 11, lines 6 – 43);

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- wherein said market rate information (exchange rate data) is received via at least one market rate data stream. (see col. 8, line 49 – col. 9, line 3);
- wherein said pricing rules (business rules) further define when to update said foreign currency prices (exchange rate data) of said goods, based on at least one of after the expiration of a predetermined time interval (frequency and timing of updates is based on business rules). (see col. 8, line 49 – col. 9, line 3);
- wherein said pricing rules (business rules) further define rules to update said foreign currency prices (exchange rate data) of said goods, based on either the actual current market rate (exchange rate data) or said actual current market rate adjusted by a predetermined amount. (see col. 8, line 49 – col. 9, line 3);
- wherein said hedging rules (programming) further define an amount to exchange said first and second types of currency, based on either a total accumulated revenue (aggregated transactions) of said first type of currency. (see col. 8, lines 49 – 58);
- wherein said steps of generating said public price information and generating said hedging instruction information are performed by the hedging processor in a computerized system (server). (see col. 3, line 50 – col. 4, line 17);
- wherein said computerized system (server) is configured within at least one of a local network (see col. 3, line 50 – col. 4, line 17);

- wherein said computerized system is configured within an application service provider (server), remote from said customer (connected to merchant/customer computer via network). (see col. 3, line 50 – col. 4, line 17);
- wherein the plurality of FX rate providers include a multi-bank website, an individual bank website, a non-bank website offering a live market foreign exchange rate stream and an exchange service based on said price stream, or any combination thereof (currency broker, bank or financial institution). (see col. 14, lines 2 – 14); and
- further comprising the step of forwarding the hedge instruction data streams (approval/disapproval) and the public price data streams (exchange rate data) as an electronic ticket (data) to at least one of said customer. (see col. 11, lines 49 – 64; col. 13, lines 35 – 60).

Boesch does not teach a method wherein receiving pricing rules from the customer and set by the customer, wherein said pricing rules define rules to update public foreign currency prices of said goods. However, Boesch does disclose a method wherein establishing pricing rules (business rules), wherein said pricing rules (business rules) define rules to update public foreign currency prices of said goods. (see col. 8, line 49 – col. 9, line 3).

Pool discloses a method wherein receiving pricing rules (currency conversion timing and display programming), wherein said pricing rules define rules to update public foreign currency prices of goods. (see col. 6, lines 4 – 50).

Boesch does not explicitly teach a method wherein said transaction data stream is received from a business-to-business (B2B) portal, wherein said B2B portal is a medium to allow said customer to buy or sell said goods; nor wherein said B2B portal is at least one of an online marketplace, a vendor website, a purchaser website, or any combination thereof. However, Boesch does disclose a method wherein said transaction data stream is received from a merchant and a customer connected to the Internet, wherein said Internet is a medium to allow said customer to buy or sell said goods (as customer shops over the network), and such a portal would be an online marketplace. (see fig. 1; col. 13, lines 5 – 27).

Pool discloses a method wherein said transaction data stream (electronic purchase orders) is received from a business-to-business (B2B) portal (an electronic catalog stored on a publicly accessible database), wherein said B2B portal is a medium (internet/intranet) to allow said customer to buy or sell said goods (ordering system); and wherein said B2B portal is at least one of an online marketplace (electronic merchandise catalogue and ordering system for use on the internet/intranet). (see col. 1, lines 9 – 49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Boesch by incorporating (1) the ability of the customer to set the frequency of updating the exchange rate and (2) transmit data from the B2B portal, as disclosed by Pool, thereby providing the customer control of the frequency of the updates, in regards to (1), and allowing the system to receive transmission data from one of the parties to the transaction, in regards to (2).

Boesch does not explicitly disclose a method wherein said hedging rules further define when to exchange said first and second types of currency, based on at least one of after a predetermined amount of units of said goods are sold or purchased, after a predetermined amount of currency received from sales or due from purchases of said goods, or any combination thereof. However, Boesch discloses a method wherein said hedging rules (instructions) further define when to exchange said first and second types of currency, based on at least one of accumulating a large aggregate number of transactions. (see col. 8, line 49 – col. 9, line 3).

Mancini discloses a method wherein said hedging rules further define when to exchange said first and second types of currency, based on at least one of after the expiration of a predetermined time interval (time period for which a fixed exchange rate has been set), after a predetermined amount of units of said goods are sold or purchased (a certain number of transactions take place), after a predetermined amount of currency received from sales or due from purchases of said goods (certain local currency notional amount has been reached), or any combination thereof. (see col. 12, lines 37 – 44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Boesch and Pool by incorporating the qualifiers for implementing a currency exchange, as disclosed by Mancini, to ensure that the optimal exchange rate was secured by the system.

Regarding Claims 19 – 37, such claims recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected

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claims, or are otherwise disclosed by the prior art applied in previously rejected claims.

Such claim limitations are therefore rejected using the same art and rationale as previously utilized. Applicant is reminded that any argument contrary to such an interpretation is an indication of patentably distinct subject matter that may warrant a restriction requirement.

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

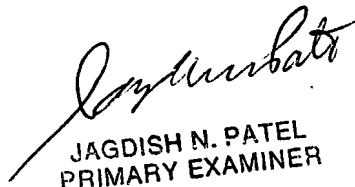
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason M. Borlinghaus (JMB)

September 4, 2007


JAGDISH N. PATEL
PRIMARY EXAMINER